REMARKS

Applicants respectfully request favorable reconsideration of this application, as amended.

In order to avoid further prolongation of the prosecution, and without acceding to the outstanding rejections under 35 U.S.C. § 112, first paragraph, and § 103(a), Claim 1 has been further amended to revise the recited dynamic viscosity range to at least 120 and not exceeding 150 mm^2/s. The newly recited lower limit finds explicit support in the disclosure of embodiment 10, for example (see page 16 of the specification). Accordingly, the rejection under § 112, first paragraph, is moot. Furthermore, the invention as set forth in amended Claim 1 clearly distinguishes patentably from Shiraishi et al. (Shiraishi), which is the basis for the outstanding rejection of Claim 1 under 35 U.S.C. § 103(a).

Shiraishi fails to teach any specific composition having both an oiliness improver (which the Office equates with Applicants' claimed extreme pressure agent) and a dynamic viscosity of at least 120 mm^2/s at 40°C. As noted in the Amendment dated January 16, 2003, the only specific examples containing an oiliness improver in Shiraishi all use base oils having a viscosity in the range of only 17-20

mm^2/s (see examples 11-16, and note also comparative examples 3-4). This is nowhere close to the viscosity range set forth in Applicants' Claim 1 and, if anything, would lead one away from the use of Shiraishi's oiliness improver in compositions with oil viscosities in Applicants' claimed range. Moreover, as previously noted in the prosecution, Applicants' invention provides a highly effective solution to the problem of fretting corrosion in grease-filled spindle support bearings, a problem that Shiraishi does not even address. Couple these facts with the fact that Shiraishi explicitly eschews the use of oils having a dynamic viscosity greater than 100 mm^2/s at 40°C, and it becomes apparent that Applicants' claimed invention would not have been obvious to one of ordinary skill in the art given the actual teachings of Shiraishi.

In response to Applicants' previous arguments, the Office contended that the disclosure of Shiraishi is not limited to its specific examples. However, the specific examples must be considered in determining what Shiraishi's disclosure would fairly teach or suggest to one of ordinary skill in the art. The specific examples containing an oiliness improver use base oils having a viscosity in the range of 17-20 mm^2/s. The examples using base oils of

higher viscosity do not contain an oiliness improver. Thus, giving due consideration to the examples, Shiraishi's disclosure would not have suggested the use of an oiliness improver with higher viscosity base oils and, if anything, would suggest the contrary. In any event, there is nothing in Shiraishi's disclosure to suggest the use of an extreme pressure agent with an oil having a dynamic viscosity of at least 120 mm^2/s at 40°C, as presently claimed, which viscosity is far outside the range taught in the reference.

Claim 1 is therefore clearly patentable over Shiraishi and should now be allowed.

The rejections of the dependent claims are of course moot in view of the patentability of Claim 1 as discussed above.

Applicants respectfully request that this application be passed to issue.

The Commissioner is hereby authorized to charge to Deposit Account No. 50-1165 any fees under 37 C.F.R. §§ 1.16 and 1.17 that may be required by this paper and to credit any overpayment to that Account. If any extension of time is required in connection with the filing of this

paper and has not been requested separately, such extension is hereby requested.

Respectfully submitted,

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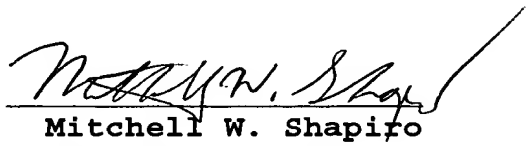
By: 
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